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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL MICHAEL DENNISON, RONALD L. HEINEY,
RICHARD J. HOWARTH, BRIAN WILLIAM MORONEY,
DWIGHT ROSS PALMER, ADAM A. SWARTZ
and JOHN STUART WALKER

Appeal 2008-004798
Application 10/065,527
Technology Center 2600

Decided: December 14, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,
and ROBERT E. NAPPI, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 to 20. We have jurisdiction under 35 U.S.C. § 6(b).

We will sustain the rejections of claims 1 to 20.

Appellants have invented a method for inserting a plurality of visual cue objects corresponding to print job parameters into an original document to create an amended document for display, removing at least one of the visual cue objects, and performing specific operations on the amended document (Figs. 1 to 3; Spec. 2 to 4; Abstract).

Claim 1 is illustrative of the claims on appeal, and it reads as follows:

1. A method comprising:

displaying a plurality of original document visual objects of an original document;

inserting into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document, and displaying the plurality of visual cue objects; and

removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects and performing the specific operations.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Koppolu	US 6,268,924 B1	Jul. 31, 2001
Simpson	US 2002/0184305 A1	Dec. 5, 2002 (filed Jun. 4, 2001)
Livingston	US 6,614,454 B1	Sep. 2, 2003 (filed Oct. 29, 1999)
Moore	US 6,880,124 B1	Apr. 12, 2005 (filed Jun. 4, 1999)

The Examiner rejected claims 4 and 12 under the first paragraph of 35 U.S.C. § 112 for lack of enablement.

The Examiner rejected claims 1, 3 to 5, 9, and 11 to 13 under 35 U.S.C. § 102(e) based upon the teachings of Livingston.

The Examiner rejected claims 2 and 10 under 35 U.S.C. § 103(a) based upon the teachings of Livingston and Moore.

The Examiner rejected claims 6 to 8 and 14 to 16 under 35 U.S.C. § 103(a) based upon the teachings of Livingston and Simpson.

The Examiner rejected claims 17 and 19 under 35 U.S.C. § 103(a) based upon the teachings of Livingston and Koppolu.

The Examiner rejected claims 18 and 20 under 35 U.S.C. § 103(a) based upon the teachings of Livingston, Simpson, and Koppolu.

Turning first to the lack of enablement rejection, Appellants have not presented any arguments to rebut the rejection.

Turning next to the anticipation rejection of claims 1, 3 to 5, 9, and 11 to 13, Appellants argue *inter alia* (App. Br. 7 to 10) that the print preview image 68 in Livingston is neither a document nor an amended document.

ISSUE

Anticipation

Have Appellants shown that the Examiner erred by finding that the print preview image in Livingston is a document that can be amended?

Obviousness

Have Appellants shown that the Examiner erred by finding that the applied references teach or would have suggested the claimed subject matter set forth in claims 2, 6 to 8, 10, and 14 to 20?

FINDINGS OF FACT (FF)

1. Appellants' disclosed and claimed invention is directed to a document that is viewed via a standard document viewing application and amended prior to a print application (Spec. 2 to 4; Abstract).
2. Appellants' disclosure does not define a "document."
3. Livingston describes a graphical user interface (GUI) for controlling printer 12 (Figs. 1 and 3A). The GUI is configured "to allow user selection and modification of print engine options for printing the *document* (col. 2, ll. 19 to 21) (emphasis added). As seen in Figure 3A, the GUI divides the display screen into a first screen portion 50, and a second screen portion 52. The first screen portion 50 displays a scrollable list of features (e.g., staple and watermarks), and the second screen portion is divided into two sub portions 56 and 58. The second sub portion 58 is configured to display controls for the currently selected feature (i.e., staple) in first screen portion 52, and the first sub portion 56 is configured to display a print preview image of "a specific page in the *document*" (col. 5, ll. 38 to 42) (emphasis added). The controls provided in first sub portion 56 allow "selection of stapling or not stapling the printed *document*" (col. 5, ll. 17 to 20) (emphasis added). If stapling is chosen, then the *document* is changed to an amended *document* by the insertion of staples to the *document*. The same holds true for the Watermarks feature. If Watermarks is selected as a feature, then the Watermark placed on the *document* changes the *document* to an amended *document*. A selected Watermark can be displayed as a transparent outline or unseen marker (col. 5, ll. 63 to 67). A feature can be removed from the amended *document* prior to the printing operation (col. 5,

1. 6 to col. 6, l. 20). A save button is located in the first screen portion 50 (Fig. 3A).

4. Moore automatically saves a document when printing (col. 7, ll. 12 to 18).

PRINCIPLES OF LAW

Anticipation

Anticipation is established when the applied reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Obviousness

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and the Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Enablement

The lack of enablement rejection of claims 4 and 12 is sustained because Appellants have not presented any arguments to rebut the Examiner's position.

Anticipation

As indicated *supra* (FF 2), Appellants have not provided a specific definition of a document. In the absence of such a definition, Appellants'

arguments that Livingston does not describe a document or an amended document are without merit. Thus, we agree with the Examiner that Livingston, like Appellants, describes a document that is amended to reflect desired features prior to a printing operation (FF 1 and 3) as set forth in claims 1 and 9, and that a selected Watermark can be an unseen marker as set forth in claims 4 and 12. In summary, the anticipation rejection is sustained because Livingston describes all of the limitations of claims 1, 3 to 5, 9, and 11 to 13. *See Atlas Powder Co.*, 190 F.3d at 1347; *Paulsen*, 30 F.3d at 1478-79.

Obviousness

The obviousness rejection of claims 2 and 10 is sustained because Livingston discloses a save button on the GUI (FF 3), and Moore describes automatic saving of a document when printing (FF 4).

The obviousness rejections of claims 6 to 8, and 14 to 20 are sustained because Appellants have not presented any patentability arguments for these claims apart from the arguments presented for claims 1 and 9. *See Oetiker*, 977 F.2d at 1445.

CONCLUSION OF LAW

Anticipation

Appellants have not demonstrated that the Examiner erred by finding that the print preview image in Livingston is a document that can be amended.

Obviousness

Appellants have not demonstrated that the Examiner erred by finding that the applied references teach or would have suggested the method steps and limitations set forth in claims 2, 6 to 8, 10, and 14 to 20.

ORDER

The decision of the Examiner rejecting claims 4 and 12 under the first paragraph of 35 U.S.C. § 112 is affirmed.

The decision of the Examiner rejecting claims 1, 3 to 5, 9, and 11 to 13 under 35 U.S.C. § 102 (e) is affirmed.

The decision of the Examiner rejecting claims 2, 6 to 8, 10, and 14 to 20 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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